

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**  
(Attorney Docket No. 005222.00184)

In re U.S. Application of: Brian R. Beams      )  
Application No. 09/934,924                          )  
Filed: August 22, 2001                                  ) Examiner: Salad, Abdullahi Elmi  
For: Creating a Virtual Consultant                  ) Group Art Unit: 2457  
    ) Confirmation No. 9686  
    )  
    )

**REPLY BRIEF**

Mail Stop Appeal Brief-Patents  
Commissioner for Patents  
P.O. Box 1450  
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Sir:

This Reply Brief, in compliance with 37 U.S.C. § 41.41, is presented in response to the Examiner's Answer mailed on November 10, 2009.

The arguments in this Reply Brief complements the arguments included in Appellant's Brief. On pages 7-9 of the Examiner's Answer, the Examiner responded to the arguments raised by the Appellant. Appellant is responding to the arguments presented by the Examiner.

**Status of the Claims**

Claims 1-19 have been cancelled. Claims 20-57 are pending and are found in the Appendix. Claims 39-57 are withdrawn from consideration. Claims 20-38 stand rejected. No claims have been allowed.

Claims 20-38 are being appealed.

**Grounds of Rejection to be Reviewed on Appeal**

Whether claims 20-38 are unpatentable under 35 U.S.C. §103(a) over U.S. Patent No. 5,310,349 (Daniels) in view of U.S. Patent No. 6,427,063 (Cook).

**Arguments****Combination of Daniels and Cook Fails to Suggest Every Feature**

Regarding independent claims 20, 29, and 30, the Examiner argues (Examiner's Answer, pages 7-8. Emphasis added.):

**In response to the applicant's arguments with respect claims 20, 29 and 30, it seems the applicant is arguing against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references.** See In re Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); In re Merck & Co., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case Daniels initially creates first virtual tutor (i.e., virtual teacher or guidance tutor) in Information management system (IMS) as the examiner maintained all along. However, examiner finds Daniels fails to disclose creating second virtual tutor. Here Cook provides agent based instruction system including agent software 10 (virtual tutor) for each student (101) which adapts to its student, and provides individualized guidance to the student and controls to the augmented computer assisted instructional materials. Thus, it would have been advantageous to incorporate agent software 10 [sic] (virtual tutor) of Cook into the system of Daniels as second virtual tutor in order to provide individualized guidance to the students of the system of Daniels. Furthermore, Cook teaches the agent software 101 becomes a virtual tutor by acting as a student's personal and individualized tutor.

Appellant respectfully disagrees. For example, while Cook may discuss a virtual tutor of student 101 that is supported by agent software 108, Cook fails to discuss anything about a second virtual tutor and consequently fails to suggest the feature of "dynamically **adding** a second virtual instructor with the first virtual instructor and the one or more users." (Emphasis added.) Daniels discusses a "virtual school" to "deliver a customized sequence of appropriate learning event to each student" (column 3, lines 25-28) while Cook discusses agent 108 that "becomes a virtual tutor by acting as a student' personal and individualized tutor" (column 11, lines 60-61). However, for example, the combination of Daniels and Cook fails to suggest coordination between the alleged virtual tutors. One virtual tutor may provide different advice at an inappropriate time to a student with respect to the other virtual advisor, thus possibly confusing

the student. Consequently, one of ordinary skill in the art at the time of the invention would merely replace the virtual tutor of Daniels with the virtual tutor of Cook or vice versa.

Claims 20, 29, and 30 are patentable over the combination of Daniels and Cook. Thus, the rejections of claims 20, 29, and 30 under 35 U.S.C. 103(a) should be reversed.

#### **Lack of Motivation to Combine Cook With Daniels**

Regarding independent claims 20, 29, and 30, the final Office Action fails to establish a *prima facie* case of obviousness because there is a lack of motivation to combine Cook with Daniels. An obviousness rejection must include some articulated reasoning that makes logical sense. *KSR Int'l Co. v. Teleflex, Inc.*, 127 S.Ct. 1727,1741 (2007). (“To facilitate review, this analysis should be made explicit. See *In re Kahn*, 441 F.3d 977, 988 (C.A.Fed.2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”.”). The Examiner argues (Examiner’s Answer, pages 7-8. Emphasis added.):

In response to the applicant's arguments with respect claims 20, 29 and 30, it seems the applicant is arguing against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case Daniels initially creates first virtual tutor (i.e., virtual teacher or guidance tutor) in Information management system (IMS) as the examiner maintained all along. However, examiner finds Daniels fails to disclose creating second virtual tutor. Here Cook provides agent based instruction system including agent software 10 (virtual tutor) for each student (101) which adapts to its student, and provides individualized guidance to the student and controls to the augmented computer assisted instructional materials. **Thus, it would have been advantageous to incorporate agent software 10 [sic] (virtual tutor) of Cook into the system of Daniels as second virtual tutor in order to provide individualized guidance to the students of the system of Daniels.** Furthermore,

Cook teaches the agent software 101 becomes a virtual tutor by acting as a student's personal and individualized tutor.

Daniels' invention, however, supports functions that include (Column 3, lines 25-40. Emphasis added.):

- 1) deliver a customized sequence of appropriate learning events to each student;
- 2) direct and monitor student progress and various online and offline activities and tailor instruction to fully integrate them into the classroom;
- 3) adapt a standard sequence of curricula and prescribe lessons from third-party materials;
- 4) branch students to appropriate remedial or enrichment activities;
- 5) generate criterion-referenced pretests and post-tests; and
- 6) create, maintain, and update instructional records on each student and electronically transfer records within and between schools.

Consequently, there is a lack of motivation to combine Cook in order to "provide individualized guidance" because Daniels already provides "a customized sequence of appropriate events for each student." Thus, the combination of Daniels and Cook is improper, and Appellant requests that the rejections of claims 20, 29, and 20 be withdrawn.

Appellant respectfully requests reversal of the above rejections. If the Board is of the opinion that any rejected claim may be allowable in amended form, Appellant would respectfully request a statement to that effect.

Respectfully submitted,

Date: January 5, 2010

By:



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